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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/118,730 07/17/98 BEAVERS

E :281-28

HM12/1014

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EXAMINER

WHITE, E

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

10/14/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/118,730

Applicant(s)

BEAVERS et al.

Examiner

WHITE

Group Art Unit

1623



☒ Responsive to communication(s) filed on Jul 16, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-8 and 20-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 and 20-23 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Amendment A filed July 16, 1999 has been received and entered into the record.
2. Claims 1-8 and 20-23 are pending in the case.
3. All 35 U.S.C. statutes not cited in this Office action can be found cited in full in a previous Office action.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 20, the term "suitable" renders the claim indefinite because it is unclear whether the limitation(s) following the term are part of the claimed invention.

### **35 U.S.C. 103 Rejection**

6. Claims 1-8 and 20-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al (US Patent No. 4,808,576) for the reasons already of record on pages 2 and 3 of the Office action filed July 16, 1999.

7. Applicant's arguments filed July 16, 1999 have been fully considered but they are not persuasive. Applicants arguments filed July 16, 1999 and the first and second Declarations under Rule 132 by Ellington M. Beavers dated July 17, 1998 and July 16, 1999 have been carefully considered but are not persuasive since the instant claimed free-acid form of hyaluronic acid sets forth no unexpected results. The Schultz et al patent discloses hyaluronic acid that can be administered to animals and humans (see abstract) and therefore appears to be within the scope of medical grade hyaluronic acid which is discussed on pages 6 and 7 of Applicants response. Any change in form (such as from a salt of a compound to the free acid form of a compound) may render an article or compound new in commerce. But to be patentable it must be more

efficacious or possess new properties and not merely a change of form which has the advantages which one skilled in the art would expect from the change. Accordingly, the rejection of claims 1-8 and 20-23 under 35 U.S.C. 103(a) as being unpatentable over Schultz et al is maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. All the claims are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*E. White*

White  
October 6, 1999

*Gary L. Kunz*  
GARY L. KUNZ  
PRIMARY EXAMINER  
GROUP 1200